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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,765	09/29/2006	Vict Stegmann	13156-00041-US1	7022
23416 7590 11/20/2007 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
			EXAMINER CUTLIFF, YATE KAI RENE	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 11/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/570,765	Applicant(s) STEGMANN ET AL.	
	Examiner Yate' K. Cutliff	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/05/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed May 5, 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the foreign patent documents and non patent literature documents were not provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Objections

2. Claim 6 is objected to because of the following informalities: the claim, as amended is improper for failing to include the deleted language. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Metz et al. (U.S. 5,767,330).

Applicant claims a process for preparing haloalkanes comprising reacting alcohol with hydrogen halide, wherein the reaction of the alcohol with the hydrogen halide occurs in the presence of an ionic liquid at a temperature which is above 100°C for at least part of the time and, at least at the time of commencement of the reaction, the water content is not more than 25 mol% based on the amount of ionic liquid, where the ionic liquid is not octyltrimethylammonium chloride.

Metz et al. discloses all of the claimed limitations, where the ionic liquid is alkylpyridine hydrochloride. See Example 2 and Table 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1- 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metz et al. (U.S. 5,767,330), in view of Ren et al. (Organic Letters, 2001, vol. 3, No. 23, pp 3727-3728), Winkler et al. (U.S. 5,202,513) and Leadbeater et al. (Tetrahedron, 35/5/2003, vol. 59, pp 2254-2255, 2257).

Applicant claims a process for preparing haloalkanes. See brief description in the 102(b) rejection. Additional claims are drawn to the identification of the alcohol, hydrogen halide and ionic liquid; temperature ranges; reaction water content and reaction steps.

The prior art Metz et al. substantially discloses the claimed invention. See the description above in 102(b) rejection. The instant claims differ in that Metz et al. does not disclose the use of HBr, the melting point of the ionic liquid, and the extensive listing of cation and anions for the ionic liquid.

Ren et al. discloses that ionic liquids, particularly 1,3-dialkylimidazolium halides (cation/anion) is useful in the conversion of alkyl alcohols to alkyl halides, such as HBr.

Winkler et al. discloses the use of various amine hydrohalides for the preparation of halogenoalkanes. (see column 1, line 56-68, column 2 lines 1-30 and Example 2).

Any remaining differences with regard to the use of ionic liquids, temperature ranges, the use of a ionic liquid with a melting point below the reaction temperature are steps within the purview of the ordinary artisan, especially in light of Leadbeater et al. which discloses rapid synthesis of alkyl halides from alcohol using ionic liquids made from organic cations and the appropriate anions. Additionally, Leadbeater et al. discloses that the reaction time and yield in the synthesis of alkyl halides from alcohols with ionic liquids (which generally have melting points close or near room temperature) are a function of temperature. In Leadbeater et al. HCl, HBr and HI produced results.

It would have been obvious to one having ordinary skill in the art to make use the process as taught by Metz et al. in view of Ren et al, Winkler et al. and Leadbeater et al. with the predictable result to produce haloalkanes by a reaction of alcohol with hydrogen halide in the presence of an ionic liquid.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

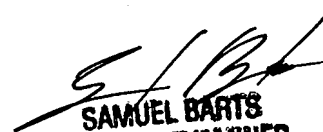
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yate' K. Cutliff whose telephone number is (571) 272-9067. The examiner can normally be reached on M-TH 8:30 a.m. - 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272 - 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yaté K. Cutliff
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SAMUEL BARTS
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